

### **REMARKS**

The indication that claims 2-7, 9-10, 13-16, and 18-21 are allowable is greatly appreciated. Claims 3, 5, 10, 14, 16, and 19 have been amended herein. Claims 29-39 have been added. Claims 1-39 are now pending in the Application. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Support for new claims 29-39 is found in the original claims, the Specification and Drawings.

New claims 30, 31, 32, 34, 35, and 36 are independent claims which correspond to allowable claims 2, 4, 9, 13, 15, 18. Thus new claims 30, 31, 32, 34, 35, and 36 should be allowable for at least the same reasons as claims 2, 4, 9, 15, 13, 18 are allowable. New claims 38 and 39 are method claims that recite method steps that correspond to features of allowable claims 2 and 4 and are also respectfully submitted to be allowable.

Allowable dependent claims 3, 5, 10, 14, 16, and 19 have been amended to depend from new independent claims 30, 31, 32, 34, 35, and 36 respectively, and should be allowable as well.

Also, new claims 29, 33 and 37 are independent claims that recite features similar to claims 1, 12 and 24, respectively, and should be allowable for at least the same reasons, which reasons are discussed below.

### **Claim Rejections**

Claims 1, 8, 11, 12, 17, and 22-28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lewis, et al., 6,082,616 ("Lewis").

These rejections are respectfully traversed.

### **The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

### **The Features Recited in Applicants’ Claims Patentably Distinguish Over Lewis**

In the Action claims 1, 8, 11, 12, 17, and 22-28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lewis. These rejections are respectfully traversed. Applicants’ response to

these rejections is based on the Office's referenced interpretation of Lewis. Thus, any change in the Office's interpretation of Lewis shall constitute a new ground of rejection.

### **Claim 1**

Claim 1 is an independent claim which is specifically directed to a cash dispensing automated banking machine. The Action points out that Lewis discloses an automated banking machine (10) which includes a roll out tray (32). Mounted to the roll out tray is a display (36), a receipt printer (40) and a fascia (42). The Action also points out that Lewis shows an opening (46) in the fascia for accepting cards.

However, claim 1 recites features which are not disclosed or suggested in Lewis. For example claim 1 recites that "the fascia is operative to move between a closed position and an open position relative the frame." The Action contends that the tray (32) shown in Lewis corresponds to the recited "frame." However Lewis does not disclose or suggest that its fascia (42) moves between a closed and an open position relative to the tray (32). Rather the entire tray rolls out of the machine with the display device, fascia, card reader, and receipt printer mounted thereon.

In addition, claim 1 recites that responsive to moving the fascia from the open position to the closed position either:

- the transaction function device is operative to move the transaction function device opening relative to the frame and into alignment with a fascia opening; or
- the fascia is operative to move the fascia opening relative to the fascia and into alignment with the transaction function device opening.

Nowhere does Lewis disclose or suggest that any of the openings in the devices mounted to the tray (e.g., an opening in the card reader (47)) is operative **to move relative the tray, responsive to the fascia moving from the open position to the closed position with respect to the tray.**

In addition, nowhere does Lewis disclose or suggest that any of the openings in its fascia (e.g., the card reader opening (46)) are operative **to move relative to the fascia (42).** Further, none of the openings in the fascia shown in Lewis are operative to move relative to the fascia **responsive to the fascia moving from the open position to the closed position with respect to the tray.**

Lewis does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejection. Hence, Applicants' claim 1 patentably distinguishes over the Lewis reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that rejected claims 8 and 11 which depend from claim 1 are likewise allowable.

### **Claim 12**

Claim 12 is an independent method claim. Claim 12 recites (a) urging a fascia of an automated banking machine to move from an open position to a closed position adjacent a frame of the automated banking machine that includes a cash dispenser. Claim 12 also includes step (b) which recites: responsive to (a), aligning a transaction function device opening in a transaction function device with a fascia opening through the fascia. Claim 12 also recites that

step (b) includes at least one of: (c) moving the location of the fascia opening relative to the fascia; and (d) moving the transaction function device opening relative to the frame.

As discussed previously with respect to claim 1, the Action contends that the tray (32) shown in Lewis corresponds to the recited “frame.” However Lewis does not disclose or suggest that its fascia (42) moves between a closed and an open position adjacent the tray (32). Rather, the entire tray rolls out of the machine with the display device, fascia, card reader, and receipt printer mounted thereon. Thus Lewis does not disclose or suggest step (a) of claim 12.

In addition Lewis does not disclose or suggest step (b) which includes at least one of step (c) and step (d).

For example with respect to step (c), nowhere does Lewis disclose or suggest that the locations of any of the openings (e.g., the card reader opening (46)) in its fascia **move relative to the fascia**. Further, none of the locations of the openings in the fascia (42) shown in Lewis move relative to the fascia **during a step of aligning a transaction function device opening with a fascia opening**. In addition, none of the locations of the openings in the fascia (42) shown in Lewis move relative to the fascia during a step of aligning a transaction function device opening with a fascia opening, which step occurs **responsive to the fascia being urged to move from an open position to a closed position adjacent the frame**.

With respect to step (d), nowhere does Lewis disclose or suggest that any of the openings in the devices mounted to the tray (e.g., an opening in card reader (47)) **move relative the tray, during a step of aligning a transaction function device opening with a fascia opening**. In addition, none of the openings in the devices shown in Lewis move relative to the tray during a step of aligning a transaction function device opening with a fascia opening, which step occurs

**responsive to the fascia being urged to move from an open position to a closed position adjacent the frame.**

Lewis does not disclose each and every element and step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, it is submitted that Applicants' claim 12 patentably distinguishes over the Lewis reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that rejected claims 17, 22 and 23 which depend from claim 12 are likewise allowable.

#### **Claim 24**

Claim 24 is an independent claim which is specifically directed to a cash dispensing automated banking machine. The Action points out that Lewis discloses an automated banking machine (10) which includes a roll out tray (32). Mounted to the roll out tray is a display (36), a receipt printer (40) and a fascia (42). The Action also points out that Lewis shows an opening (46) in the fascia for accepting cards.

However, claim 1 recites features which are not disclosed or suggested in Lewis. For example claim 1 recites that responsive to at least one of the fascia and the transaction function device moving from the spaced part position to the adjacent position, either:

- the transaction function device is operative to move the transaction function device opening relative to the frame and into alignment with the fascia opening; or
- the fascia is operative to move the fascia opening relative the fascia and into alignment with the transaction function device opening.

Nowhere does Lewis disclose or suggest these features. For example, nowhere does Lewis disclose or suggest that any of the devices mounted to the tray (e.g., the card reader (47)) are operative to **move their openings relative to the tray** and into alignment with openings (e.g., card opening (46)) in the fascia, **responsive to at least one of the fascia and the transaction function device moving from the spaced part position to the adjacent position.**

In addition, nowhere does Lewis disclose or suggest that any of the openings in its fascia (e.g., the card reader opening (46)) **move relative to the fascia** and into alignment with the openings to devices (e.g., the card reader (47)). Further, none of the openings in the fascia shown in Lewis move relative to the fascia and into alignment with transaction function device openings **responsive to at least one of the fascia and the transaction function device moving from the spaced part position to the adjacent position.**

Lewis does not disclose each and every element of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Applicants' claim 24 patentably distinguishes over the Lewis reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome. It follows that rejected claims 25-27 which depend from claim 24 are likewise allowable.

#### **Claim 28**

Claim 28 is an independent method claim. Claim 28 recites (a) urging a transaction function device of an automated banking machine to move relative to a frame from a service position to a position adjacent a fascia of the machine. The automated banking machine includes a cash dispenser. Claim 28 also includes step (b) which recites: responsive to (a), aligning an

opening to the transaction function device with an opening through the fascia. Claim 28 also recites that step (b) includes at least one of: (c) moving the location of the opening through the fascia relative to the fascia; and (d) moving the opening to the transaction function device relative to the frame.

As discussed previously with respect to claim 1, the Action contends that the tray (32) shown in Lewis corresponds to the recited “frame.” However Lewis does not disclose or suggest that any of its devices on the tray ever moves relative the tray from a service position to a position adjacent the fascia. Rather the entire tray rolls out of the machine with the display device, fascia, card reader, and receipt printer mounted thereon. Thus Lewis does not disclose or suggest step (a) of claim 28.

In addition Lewis does not disclose or suggest step (b) which includes at least one of step (c) and step (d).

For example with respect to step (c), nowhere does Lewis disclose or suggest that the locations of any of the openings (e.g., the card reader opening (46)) through the fascia **move relative to the fascia** (42). Further, none of the locations of the openings through the fascia shown in Lewis move relative to the fascia **during a step of aligning a transaction function device opening with a fascia opening**. In addition, none of the locations of the openings through the fascia shown in Lewis move relative to the fascia during a step of aligning a transaction function device opening with a fascia opening, which step occurs **responsive to the transaction function device being urged to move relative to the frame from a service position to a position adjacent the fascia**.



With respect to step (d), nowhere does Lewis disclose or suggest that any of the openings in the devices mounted to the tray (e.g., an opening in card reader (47)) **move relative to the tray, during a step of aligning a transaction function device opening with a fascia opening.** In addition, none of the openings in the devices shown in Lewis move relative to the tray during a step of aligning a transaction function device opening with a fascia opening, which step occurs **responsive to the transaction function device being urged to move relative to the frame from a service position to a position adjacent the fascia.**

Lewis does not disclose each and every element and step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the objection. Hence, Applicants' claim 28 patentably distinguishes over the Lewis reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection has been overcome.

#### **Additional Claim Fees**

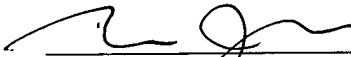
Please charge the fees associated with prosecution of eleven additional independent claims in excess of three (\$2,200) and eleven additional total claims in excess of twenty (\$550) and any other fee due, to Deposit Account No. 09-0428 (Diebold Self-Service Systems).

### Conclusion

The indication that claims 2-7, 9-10, 13-16, and 18-21 are allowable is greatly appreciated. Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke  
231 South Broadway  
Medina, Ohio 44256  
(330) 722-5143

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